

**REMARKS**

This amendment is in response to the Office Action of November 15, 2005.

Claims 1 through 24 are currently pending in the application.

Claims 1, 15, 19, 21, and 24 have been amended herein. Support for the amendments may be found in paragraphs [0019] and [0025] and FIGS. 1 and 2. No new matter has been entered to the disclosure as the amendment clearly complies with 35 U.S.C. § 132. The amendments are to clarify the invention and clearly distinguish over the prior art. The amendments are made without prejudice or disclaimer.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on Shimizu *et al.* (EP 1 056 247 A2)**

Claims 1, 12, 13, 15, 16, 18 through 21, and 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Shimizu *et al.* (EP 1 056 247 A2) ("Shimizu"). Applicant notes that Shimizu was published on November 29, 2000 and the present application was filed on September 28, 2001. Therefore, 35 U.S.C. § 102(b) could not apply. Applicant will treat the rejection as based upon 35 U.S.C. § 102(e). Applicant respectfully traverses the 35 U.S.C. § 102(e) rejection.

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Presently amended independent claim 1 recites a method of sending a print job to a printer, comprising . . . attaching at least one document to an e-mail message; sending the e-mail message over a network to an e-mail enabled printer, where the e-mail enabled printer includes e-mail client software; and extracting the at least one document from the e-mail message by the e-mail enabled printer.

Applicant asserts that Shimizu does not identically describe, either expressly or inherently, each and every element of presently amended independent claim 1 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Shimizu does not describe the element of the presently amended

claimed invention calling for “sending the e-mail message over a network to an e-mail enabled printer, where the e-mail enabled printer includes e-mail client software.” Shimizu describes an e-mail client as part of the software module within the application server 105. *See paragraphs [0047] and [0048] and FIG. 5.* There is no reference whatsoever in Shimizu to a printer including e-mail client software. Therefore, Shimizu does not anticipate presently amended claim 1 under 35 U.S.C. § 102. Therefore, presently amended independent claim 1 is allowable.

Claims 12 and 13 are allowable for at least the reason of depending from allowable presently amended independent claim 1.

Presently amended independent claim 15 recites a method of distributing a document for printing, comprising . . . attaching at a workstation at least one document to an e-mail message; sending the e-mail message to an e-mail enabled print server of a local network; extracting the at least one document at the e-mail enabled print server; and sending the at least one document to a network printer of the local network by the e-mail enabled print server.

Applicant asserts that Shimizu does not identically describe, either expressly or inherently, each and every element of presently amended independent claim 15 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Shimizu does not describe the element of the presently amended claimed invention calling for “attaching at a workstation at least one document to an e-mail message.” Shimizu describes a printing system which allows e-mail users utilizing only cellular telephones or PDAs without a printing function to perform printing even if the users do not possess a PC. *See, e.g., paragraph [0006] and FIG. 1.* There is no reference whatsoever in Shimizu to utilizing workstations rather than cellular telephones or PDAs. Therefore, Shimizu does not anticipate presently amended claim 15 under 35 U.S.C. § 102. Therefore, presently amended independent claim 15 is allowable.

Claims 16 and 18 are allowable for at least the reason of depending from allowable presently amended independent claim 15.

Presently amended independent claim 19 recites a system for receiving and distributing a remotely sent print job to a network printer, comprising . . . an e-mail enabled print server device for communication with a network, the e-mail enabled print server

configured for receiving from a remote workstation an e-mail message having a document sent as a print job attached thereto, the e-mail enabled print server configured for extracting the document from the e-mail message and for transmitting the document to at least one network printer device; and a network printer device configured to be communicatively coupled to the e-mail enabled print server device over the network, the network printer device configured for storing and for printing print jobs transmitted by the e-mail enabled print server device.

Applicant asserts that Shimizu does not identically describe, either expressly or inherently, each and every element of presently amended independent claim 19 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Shimizu does not describe the element of the presently amended claimed invention calling for "the e-mail enabled print server configured for receiving from a remote workstation an e-mail message having a document sent as a print job attached thereto." Shimizu describes a printing system which allows e-mail users utilizing only cellular telephones or PDAs without a printing function to perform printing even if the users do not possess a PC. *See, e.g., paragraph [0006] and FIG. 1.* There is no reference in Shimizu to utilizing remote workstations rather than cellular telephones or PDAs. Therefore, Shimizu does not anticipate presently amended claim 19 under 35 U.S.C. § 102. Therefore, presently amended independent claim 19 is allowable.

Claim 20 is allowable for at least the reason of depending from allowable presently amended independent claim 19.

Presently amended claim 21 recites a computer system for processing print jobs, comprising . . . an e-mail enabled device for creating and sending e-mail with attachments; an e-mail enabled printer incorporating e-mail client software for receiving e-mails, extracting attachments from said e-mails, and printing said attachments; and a network for communicating e-mail between said e-mail enabled device and said e-mail enabled printer.

Applicant asserts that Shimizu does not identically describe, either expressly or inherently, each and every element of presently amended independent claim 21 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Shimizu does not describe the element of the presently amended

claimed invention calling for “an e-mail enabled printer incorporating e-mail client software for receiving e-mails.” Shimizu describes an e-mail client as part of the software module within the application server 105. *See paragraphs [0047] and [0048] and FIG. 5.* There is no reference whatsoever in Shimizu to a printer incorporating e-mail client software. Therefore, Shimizu does not anticipate presently amended claim 21 under 35 U.S.C. § 102. Therefore, presently amended independent claim 21 is allowable.

Presently amended independent claim 24 recites a computer system for processing print jobs, comprising . . . a local or remote workstation for creating and sending e-mail with attachments; an e-mail enabled print server for receiving said e-mail with attachments, extracting said attachments from said e-mail, and sending said attachments for printing; a network printer for receiving and printing said attachments extracted from said e-mail by said e-mail enabled print server; and a network for facilitating communications between said e-mail enabled device, said e-mail enabled server, and said network printer.

Applicant asserts that Shimizu does not identically describe, either expressly or inherently, each and every element of presently amended claim 24 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Shimizu does not describe the element of the presently amended claimed invention calling for “a local or remote workstation for creating and sending e-mail with attachments.” Shimizu describes a printing system which allows e-mail users utilizing only cellular telephones or PDAs without a printing function to perform printing even if the users do not possess a PC. *See, e.g., paragraph [0006] and FIG. 1.* There is no reference whatsoever in Shimizu to utilizing local or remote workstations rather than cellular telephones or PDAs. Therefore, Shimizu does not anticipate presently amended claim 24 under 35 U.S.C. § 102. Therefore, presently amended independent claim 24 is allowable.

### **35 U.S.C. § 103(a) Obviousness Rejections**

#### **Obviousness Rejection Based on Shimizu**

Claims 2 through 7, 9, 11, 17, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu. Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant further asserts that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Regarding claims 2 through 7, 9, and 11, applicant asserts that Shimizu does not teach or suggest all of the claim limitations of presently amended independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, presently amended independent claim 1 is allowable. Claims 2 through 7, 9, and 11 are allowable for at least the reason of depending from allowable presently amended independent claim 1.

Regarding claim 17, applicant asserts that Shimizu does not teach or suggest all of the claim limitations of presently amended independent claim 15 to establish a *prima facie* case of obviousness regarding the invention of claim 15 under 35 U.S.C. § 103. Therefore, presently amended independent claim 15 is allowable. Claim 17 is allowable for at least the reason of depending from allowable presently amended independent claim 15.

Regarding claim 22, applicant asserts that Shimizu does not teach or suggest all of the claim limitations of presently amended independent claim 21 to establish a *prima facie* case of obviousness regarding the invention of claim 21 under 35 U.S.C. § 103. Therefore, presently amended independent claim 21 is allowable. Claim 22 is allowable for at least the reason of depending from allowable presently amended independent claim 21.

#### Obviousness Rejection Based on Shimizu in view of Fabbio *et al.* (U.S. Patent 5,870,089)

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of Fabbio *et al.* (U.S. Patent 5,870,089) ("Fabbio"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claim 8, applicant asserts that Shimizu and Fabbio, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of presently amended

independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, presently amended independent claim 1 is allowable. Claim 8 is allowable for at least the reason of depending from allowable presently amended independent claim 1.

Obviousness Rejection Based on Shimizu in view of Harkins *et al.* (U.S. Patent 5,689,642)

Claims 10, 14, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of Harkins *et al.* (U.S. Patent 5,689,642) (“Harkins”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claims 10 and 14, applicant asserts that Shimizu and Harkins, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of presently amended independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, presently amended independent claim 1 is allowable. Claims 10 and 14 are allowable for at least the reason of depending from allowable presently amended independent claim 1.

Regarding claim 23, applicant asserts that Shimizu and Harkins, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of presently amended independent claim 21 to establish a *prima facie* case of obviousness regarding the invention of claim 21 under 35 U.S.C. § 103. Therefore, presently amended independent claim 21 is allowable. Claim 23 is allowable for at least the reason of depending from allowable presently amended independent claim 21.

After carefully considering the cited prior art, the rejections, and the Examiner’s comments, Applicant has amended the claimed invention to clearly distinguish over the cited prior art.

Applicant submits that claims 1 through 24 are clearly allowable over the cited prior art.

Applicant requests the allowance of claims 1 through 24 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James R. Duzan".

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